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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,820	04/16/2004	William C. Kimbrell	5739	8687

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EXAMINER	
PIZIALI, ANDREW T	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/825,820	KIMBRELL ET AL.	
	Examiner	Art Unit	
	Andrew T. Piziali	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/15/2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) *15-24* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species Group I, claims 1-14, in the reply filed on 8/15/2005, is acknowledged. Claim 15-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-10 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3,620,366 to Parkinson et al. (hereinafter referred to as Parkinson) in view of USPN 5,187,005 to Stahle et al. (hereinafter referred to as Stahle).

Regarding claims 1-10 and 13-14, Parkinson discloses an adhesive textile composite, said adhesive-textile composite comprising a textile component having a face side and a back side, said textile component being comprised of organic fibers and wherein at least the face side of said textile component comprises a hydrophobic surface, and wherein a pressure sensitive adhesive is applied to the back side of said textile component (see entire document including column 1, lines 40-49, column 2, lines 47-56, and column 3, lines 37-52).

Parkinson is silent with regards to specific tear strengths, therefore, it would have been necessary and thus obvious to look to the prior art for conventional tear strengths. Stahle provides this conventional teaching showing that it is known in the wall covering art to make

wall coverings with high tear strengths, such as at least 10 pounds in the machine and cross-machine directions, because a high tear strength is desired (see entire document including column 18, lines 36-44 and the Examples). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the textile with the claimed high tear strength, motivated by the expectation of successfully practicing the invention of Parkinson and because a high tear strength is desired.

Regarding claim 2, Parkinson discloses that the surface of the textile may be treated with silicones or waxes (column 2, lines 47-56).

Regarding claim 3, Parkinson discloses that the textile component may be bonded (column 3, lines 37-52). In addition, Stahle discloses that it is known in the wall covering art to use a woven textile component (column 2, lines 20-30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the textile component from any suitable textile structure, such as a woven textile, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability.

Regarding claims 4-5 and 7-8, Parkinson discloses that the fibers may comprise polyester (column 3, lines 37-52).

Regarding claim 6, Parkinson discloses that the adhesive may be acrylate-based (column 3, lines 12-36).

Regarding claims 7-9, Parkinson does mention the specifically claimed adhesive properties, but Parkinson does disclose that the pressure sensitive adhesive may be any material which will give adequate adhesion to the wall and will permit both easy unreeling of the rolls and removal of the paper from walls by peeling (column 3, lines 12-24). Considering that the

current specification discloses that the claimed composite possesses these identical adhesive characteristics, it appears that the composite taught by the applied prior art inherently possesses the claimed adhesive properties.

The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

Regarding claim 10, Parkinson discloses that the pressure sensitive adhesive enables the paper to be stuck to the wall and yet permits removal of the paper by merely pulling the paper from the wall (column 1, lines 61-74).

Regarding claim 13, Parkinson does not specifically mention the use an antimicrobial compound, but Stahle discloses that it is known in the wall covering art to add an antimicrobial compound to improve antimicrobial properties (column 18, lines 5-12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add an antimicrobial compound to the composite of Parkinson, because the antimicrobial compound would improve antimicrobial properties.

Regarding claim 14, Parkinson does not specifically mention the use a flame retardant compound, but Stahle discloses that it is known in the wall covering art to add a flame retardant

compound to improve flame resistance (column 9, lines 36-53). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add an flame retardant compound to the composite of Parkinson, because the flame retardant compound would improve flame resistance.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3,620,366 to Parkinson in view of USPN 5,187,005 to Stahle as applied to claims 1-10 and 13-14 above, and further in view of anyone of USPN 6,194,064 to Keely et al. (hereinafter referred to as Keely), USPN 4,783,354 to Fagan, or USPN 5,676,785 to Samonides.

Parkinson does not specifically mention the use of a thickener, but Keely, Fagan, and Samonides each disclose that it is known in the wall covering pressure sensitive adhesive art to add a thickener to improve processing and/or quality (see entire documents including column 3, lines 27-37 of Keely, column 2, lines 46-55, column 5, lines 59-65, and the examples of Fagan, and column 3, lines 35-59 of Samonides). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a thickening agent to the pressure sensitive adhesive of Parkinson, because the thickening agent would improve processing and/or quality.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3,620,366 to Parkinson in view of USPN 5,187,005 to Stahle as applied to claims 1-10 and 13-14 above, and further in view of USPN 5,639,539 to DeProspero et al. (hereinafter referred to as DeProspero).

Parkinson does not specifically mention the use of a stain release composition, but

DeProspero discloses that it is known in the wall covering art to add a stain release composition to resist staining (see entire document including column 4, lines 18-32). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a stain release agent to the composite of Parkinson, because the stain release agent would help the composite resist staining.

6. Claims 1-3, 6, 9-10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,639,539 to DeProspero in view of USPN 5,187,005 to Stahle.

Regarding claims 1-3, 6, 9-10 and 12-14, DeProspero discloses an adhesive textile composite, said adhesive-textile composite comprising a textile component having a face side and a back side, said textile component being comprised of organic fibers and wherein at least the face side of said textile component comprises a hydrophobic surface, and wherein a pressure sensitive adhesive is applied to the back side of said textile component (see entire document including column 1, lines 56-61, column 4, lines 18-61, and column 5, lines 38-45).

DeProspero is silent with regards to specific tear strengths, therefore, it would have been necessary and thus obvious to look to the prior art for conventional tear strengths. Stahle provides this conventional teaching showing that it is known in the wall covering art to make wall coverings with high tear strengths, such as at least 10 pounds in the machine and cross-machine directions, because a high tear strength is desired (see entire document including column 18, lines 36-44 and the Examples). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the textile with the claimed high tear strength, motivated by the expectation of successfully practicing the invention of DeProspero and because a high tear strength is desired.

Regarding claim 2, DeProspero discloses that the surface of the textile may be treated with fluorochemicals, silicones or waxes (column 4, line 18 through column 5, line 37).

Regarding claim 3, DeProspero discloses that the textile component may be bonded, woven, or nonwoven (column 3, lines 6-24).

Regarding claim 6, DeProspero discloses that the adhesive may be acrylate-based (column 5, line 46 through column 6, line 3).

Regarding claim 9, DeProspero does mention the specifically claimed adhesive property, but DeProspero does disclose that the pressure sensitive adhesive may be any material which will allow the wall covering to be readily repositionable during installation, removable after an extended period of use, and separated from another wall covering if the two come in contact (column 1, lines 56-61). Considering that the current specification discloses that the claimed composite possesses these substantially identical adhesive characteristics, it appears that the composite taught by the applied prior art inherently possesses the claimed adhesive properties.

Regarding claim 10, DeProspero discloses that the pressure sensitive adhesive enables the paper to be removed cleanly (column 5, lines 38-46).

Regarding claim 12, DeProspero discloses that the composite may comprise a stain release composition (column 4, lines 18-32).

Regarding claim 13, DeProspero does not specifically mention the use an antimicrobial compound, but Stahle discloses that it is known in the wall covering art to add an antimicrobial compound to improve antimicrobial properties (column 18, lines 5-12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add an

antimicrobial compound to the composite of DeProspero, because the antimicrobial compound would improve antimicrobial properties.

Regarding claim 14, DeProspero does not specifically mention the use a flame retardant compound, but Stahle discloses that it is known in the wall covering art to add a flame retardant compound to improve flame resistance (column 9, lines 36-53). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add an flame retardant compound to the composite of DeProspero, because the flame retardant compound would improve flame resistance.

7. Claims 4-5 and 7-8 are is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,639,539 to DeProspero in view of USPN 5,187,005 to Stahle as applied to claims 1-3, 6, 9-10 and 12-14 above, and further in view of anyone of USPN 3,620,366 to Parkinson or USPN 4,783,354 to Fagan.

Regarding claims 4-5 and 7-8, DeProspero discloses that the substrate may be any suitable material known in the wall covering art (column 3, lines 6-23), but DeProspero does not specifically mention the use of polyester. Parkinson and Fagan each disclose that it is known in the wall covering art to use polyester as a substrate material (see entire documents including column 3, lines 37-52 of Parkinson and column 7, lines 18-30 of Fagan). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the substrate from any suitable substrate material, such as polyester, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability.

Regarding claims 7-8, DeProspero does mention the specifically claimed adhesive property, but DeProspero does disclose that the pressure sensitive adhesive may be any material which will allow the wall covering to be readily repositionable during installation, removable after an extended period of use, and separated from another wall covering if the two come in contact (column 1, lines 56-61). Considering that the current specification discloses that the claimed composite possesses these substantially identical adhesive characteristics, it appears that the composite taught by the applied prior art inherently possesses the claimed adhesive properties.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,639,539 to DeProspero in view of USPN 5,187,005 to Stahle as applied to claims 1-3, 6, 9-10 and 12-14 above, and further in view of anyone of USPN 6,194,064 to Keely, USPN 4,783,354 to Fagan, or USPN 5,676,785 to Samonides.

DeProspero does not specifically mention the use of a thickener, but Keely, Fagan, and Samonides each disclose that it is known in the wall covering pressure sensitive adhesive art to add a thickener to improve processing and/or quality (see entire documents including column 3, lines 27-37 of Keely, column 2, lines 46-55, column 5, lines 59-65, and the examples of Fagan, and column 3, lines 35-59 of Samonides). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a thickening agent to the pressure sensitive adhesive of DeProspero, because the thickening agent would improve processing and/or quality.

9. Claims 1, 3-5 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,262,444 to Rusincovitch et al. (hereinafter referred to as Rusincovitch) in view of USPN 5,187,005 to Stahle.

Regarding claims 1, 3-5 and 13-14, Rusincovitch discloses an adhesive textile composite, said adhesive-textile composite comprising a textile component having a face side and a back side, said textile component being comprised of organic fibers and wherein at least the face side of said textile component comprises a hydrophobic surface (polyester film surface is naturally hydrophobic, see current specification page 4, lines 20-21), and wherein a pressure sensitive adhesive is applied to the back side of said textile component (see entire document including column 2, line 2 through column 3, line 19, column 6, lines 4-6 and column 7, lines 36-47).

Rusincovitch is silent with regards to specific tear strengths, therefore, it would have been necessary and thus obvious to look to the prior art for conventional tear strengths. Stahle provides this conventional teaching showing that it is known in the wall covering art to make wall coverings with high tear strengths, such as at least 10 pounds in the machine and cross-machine directions, because a high tear strength is desired (see entire document including column 18, lines 36-44 and the Examples). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the textile with the claimed high tear strength, motivated by the expectation of successfully practicing the invention of Rusincovitch and because a high tear strength is desired.

Regarding claim 3, Rusincovitch discloses that the textile component may have a woven or nonwoven construction (column 7, lines 26-47).

Regarding claims 4-5, Rusincovitch discloses that the fibers may comprise polyester (column 7, lines 26-47).

Regarding claim 13, Rusincovitch does not specifically mention the use an antimicrobial compound, but Stahle discloses that it is known in the wall covering art to add an antimicrobial compound to improve antimicrobial properties (column 18, lines 5-12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add an antimicrobial compound to the composite of Rusincovitch, because the antimicrobial compound would improve antimicrobial properties.

Regarding claim 14, Rusincovitch does not specifically mention the use a flame retardant compound, but Stahle discloses that it is known in the wall covering art to add a flame retardant compound to improve flame resistance (column 9, lines 36-53). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add an flame retardant compound to the composite of Rusincovitch, because the flame retardant compound would improve flame resistance.

10. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,262,444 to Rusincovitch in view of USPN 5,187,005 to Stahle as applied to claims 1, 3-5 and 13-14 above, and further in view of USPN 3,620,366 to Parkinson.

Regarding claims 6-9, Rusincovitch is silent with regards to specific pressure sensitive adhesives, therefore, it would have been necessary and thus obvious to look to the prior art for conventional pressure sensitive adhesives. Parkinson provides this conventional teaching showing that it is known in the wall covering pressure sensitive adhesive art to use any material which will give adequate adhesion to the wall and will permit both easy unreeling of the rolls

and removal of the paper from walls by peeling, such as an acrylate-based adhesive (column 3, lines 12-36). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the pressure sensitive adhesive an acrylate-based pressure sensitive adhesive as taught by Parkinson, motivated by the expectation of successfully practicing the invention of Rusincovitch. Considering that the current specification discloses that the claimed composite possesses these identical adhesive characteristics, it appears that the composite taught by the applied prior art inherently possesses the claimed adhesive properties.

Regarding claim 10, Parkinson discloses that the pressure sensitive adhesive enables the paper to be stuck to the wall and yet permits removal of the paper by merely pulling the paper from the wall (column 1, lines 61-74).

11. Claims 6-10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,262,444 to Rusincovitch in view of USPN 5,187,005 to Stahle as applied to claims 1, 3-5 and 13-14 above, and further in view of USPN 5,639,539 to DeProspero.

Regarding claims 6-9, Rusincovitch is silent with regards to specific pressure sensitive adhesives, therefore, it would have been necessary and thus obvious to look to the prior art for conventional pressure sensitive adhesives. DeProspero provides this conventional teaching showing that it is known in the wall covering pressure sensitive adhesive art to use any material which will allow the wall covering to be readily repositionable during installation, removable after an extended period of use, and separated from another wall covering if the two come in contact, such as an acrylate-based adhesive (column 1, lines 56-61 and column 5, line 46 through column 6, line 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the pressure sensitive adhesive an acrylate-based

pressure sensitive adhesive as taught by DeProspero, motivated by the expectation of successfully practicing the invention of Rusincovitch. Considering that the current specification discloses that the claimed composite possesses these identical adhesive characteristics, it appears that the composite taught by the applied prior art inherently possesses the claimed adhesive properties.

Regarding claim 10, DeProspero discloses that the pressure sensitive adhesive enables the paper to be removed cleanly (column 5, lines 38-46).

Regarding claim 12, Rusincovitch does not specifically mention the use of a stain release composition, but DeProspero discloses that it is known in the wall covering art to add a stain release composition to resist staining (see entire document including column 4, lines 18-32). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a stain release agent to the composite of Rusincovitch, because the stain release agent would help the composite resist staining.

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,262,444 to Rusincovitch in view of USPN 5,187,005 to Stahle as applied to claims 1, 3-5 and 13-14 above, and further in view of anyone of USPN 6,194,064 to Keely, USPN 4,783,354 to Fagan, or USPN 5,676,785 to Samonides.

Rusincovitch does not specifically mention the use of a thickener, but Keely, Fagan, and Samonides each disclose that it is known in the wall covering pressure sensitive adhesive art to add a thickener to improve processing and/or quality (see entire documents including column 3, lines 27-37 of Keely, column 2, lines 46-55, column 5, lines 59-65, and the examples of Fagan, and column 3, lines 35-59 of Samonides). It would have been obvious to one having ordinary

skill in the art at the time the invention was made to add a thickening agent to the pressure sensitive adhesive of Rusincovitch, because the thickening agent would improve processing and/or quality.

Conclusion

13. The following patents are cited to further show the state of the art with respect to hydrophobic wall covering surfaces and pressure sensitive adhesive tear strengths:

USPN 4,555,441 to Rothenburg

(see entire document including column 2, lines 16-32 and column 3, lines 14-38)

USPN 5,743,775 to Baurmeister

(see entire document including column 10, lines 29-60)

USPN 6,372,335 to Luhmann et al.

(see entire document including column 5, lines 31-38)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

atp

9/8/05

ANDREW T. PIZIALI
PATENT EXAMINER